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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/438,989 | 11/12/1999 | YOGESH S. SANGHVI | ISIS-4288 | 1111 |

7590 04/04/2003

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EXAMINER

OWENS JR. HOWARD V

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1623

DATE MAILED: 04/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n N .

09/438,989

Applicant(s)

SANGHVI ET AL.

Examin r

Howard V Owens

Art Unit

1623

--The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

THE REPLY FILED 11 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

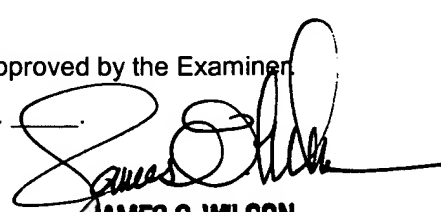
Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 23-43.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.


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SUPERVISORY PATENT EXAMINER
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Throughout prosecution, applicant has argued that the claimed 3 regions are not found in the prior art; However, there has not been a response to the examiner's argument that the 3 regions as defined by the specification are clearly set forth in the prior art of record. There has not been a specific response as to why the definition of these regions as set forth in the specification is not set forth in the prior art. As cited in the final rejection, "the external region is any compound (emphasis added) connected to either side of the chiral phosphorothioate (the internal region) ,i.e. a nucleoside (p. 27, lines 30-35 of specification). Substituents are defined as groups attached to a 2', 3' or 5' position of a sugar moiety as well as groups attached to the N2 or N6 position of the purine base or the N4 or C5 position of the pyrimidine (p.22, lines 9-20 of specification)". The fact that the terms "internal" and "external" are not set forth in the prior art is not probative to the 35 U.S.C. 102/103 rejections of record. The scope of the structure(s) encompassed by these terms as defined by applicant is pertinent and applicant does not address the scope of these terms as taught by the specification in relation to the prior art rejection.

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